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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/110,103 07/01/98 POWERS

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EXAMINER

TEITELBAUM, A

ART UNIT

PAPER NUMBER

2163

DATE MAILED: 11/22/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/110,103

Applicant(s)

POWERS ET AL.

Examiner

Anne H Teitelbaum

Art Unit

2163

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2000.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☒ The proposed drawing correction filed on 18 September 2000 is: a) ☒ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) _____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

DETAILED ACTION

1. This communication is in response to applicant's amendments filed on September 18 2000.
2. Examiner acknowledges amendments to the specification and withdraws the claim objections (paper 8, paragraph 2)
3. Examiner acknowledges changes to the drawings.
4. Examiner acknowledges applicant's changes to the claims to overcome the 101 rejection. Applicant has amended so that the invention is in the technological arts, however, the claims still recite nonfunctional steps and are analyzed as non-statutory subject matter as described in the previous action (paper 8, paragraph 4).
5. Examiner acknowledges changes to claims, however applicant did not significantly alter the meaning of the claims, therefore the rejections from the previous action remain. However, examiner notes that applicant added a limitation to claim 1, in addition to new claims 9-16, that are dealt with in the 102 and 103 rejection sections. Applicant's amendments are also discussed below in the response to arguments.

Response to Arguments

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6. Applicant's arguments filed 9/18/00 have been fully considered but they are not persuasive.

7. Applicant claims that "*Havens* fails to disclose, teach or suggest storing a user-defined configuration for a data file comprising external productivity data, the configuration operable to identify external productivity data items in the data file and to map external productivity data items to data elements for the evaluation process and mapping external productivity data items from the data file to the data elements based on the configuration". Examiner respectfully disagrees. Applicant's amendment of, "mapping external productivity data from the data file to the data elements" is newly added to the claims, so examiner did not claim that *Havens* disclosed this in her first action. However, *Havens* does indeed teach this feature (col. 7, lines 35-57), as is shown in the next section where the 102 rejections are described.

By Applicant's own admission (specification page 8, lines 22-23) applicant disclose that "the data importer imports productivity data from external sources such as a telephony switch". Therefore, *Haven's* retriever, which performs the identical functions as importing data reads on applicant's claims. For more detail in *Haven's* see col. 7, lines 1-5:

"The present invention contemplates retrieving information, including survey data and benchmark values, from database in any manner suitable to allow system to generate one or more knowledge worker productivity assessments using some or all of the information."

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Therefore, claim 1 remains rejected under 35 USC 102 (e). In addition, claim 7 remains rejected for the same reasons discussed above. Since claims 1 and 7 are rejected, dependent claims 2-6 and 9-10 also remain rejected since applicant has not shown them to be otherwise.

Claim Rejections - 35 USC § 102

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 1-8 and 11-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Havens (US 5,909,669).

See paper 8, paragraph 6 for the rejection for claims 1-8.

Newly added matter in claim 1:

mapping external productivity data items from the data file to the data elements based on the configuration (col. 7, lines 35-57).

Claim 11-14:

Claims 11-14 are directed to the functionality of the method claims. (Col. 14, lines 40-44 and col. 10, line 62 to col. 11, line 28).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 9-10 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Havens (US 5,909,669).

Claims 9-10 and 15-16:

Claims 9-10 are directed to receiving the data file from an external device (col. 12, lines 17-27) and the external device comprises a telephony switch. However, Havens fails to disclose that the external device is a telephony switch. Official notice is taken that it is old and well known in the computer art to access information for a computer with a telephone switch. This is the easiest and most efficient way to get information quickly to make an assessment, in this case, a performance evaluation or a worker assessment. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of applicant's invention to use a telephony switch as an external device because it is a common method of retrieving information that is standard on most computers.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne H Teitelbaum whose telephone number is 703-306-5679. The examiner can normally be reached on Monday-Thursday 7:30am-5:00pm and alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-9051 for regular communications and 703-308-5337 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

aht
November 20, 2000

A handwritten signature in black ink, appearing to read "Eric W. Stamber". The signature is fluid and cursive, with the first name "Eric" and last name "Stamber" clearly distinguishable.

ERIC W. STAMBER
PRIMARY EXAMINER